REMARKS

Claims 1-30 are pending.

The final Office Action mailed July 27, 2005 rejected claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18, 19, 21, 22, 24, 25, 27, 28, and 30 as obvious under 35 U.S.C. § 103(a) based on *Kozdon et al.* (U.S. 6,456,601) in view of *Flockhart et al.* (U.S. 6,820,260), claims 2, 8, 14, 20, and 26 as obvious under 35 U.S.C. § 103(a) based on *Kozdon et al.* and *Flockhart et al.* and further in view of *Anjum et al.* (U.S. Publication No. 2001/0028654 A1), and claims 5, 11, 17, 23, and 29 as obvious under 35 U.S.C. § 103(a) based on *Kozdon et al.* and *Flockhart et al.* and further in view of *Hazenfield* (U.S. 5,991,374).

Independent claim 1 recites "wherein the server is configured to generate a request message, in response to the hold condition, for performing call control on behalf of the first client by transmitting the request message to the other server to instruct the other server to transmit the content to the second client" and "wherein the server is configured to generate a request message, in response to the hold condition, for performing call control on behalf of the first client by transmitting the request message to the other server to **instruct the other server to transmit the content to the second client**." Claims 7 and 25 recite "generating a request message, in response to the hold condition, for performing call control on behalf of the first client" and "transmitting the request message to a content server to **instruct the content server to transmit content stored therein to the second client**." Claim 13 recites "a processor coupled to the communications interface and configured to generate a request message, in response to the hold condition, for performing call control on behalf of the first client by transmitting the request message to a content server to **instruct the content server to transmit content stored therein to the second client**." Also, claim 19 recites "means for generating a request message, in response to the hold condition, for performing call control on behalf of the first client" and

"means for transmitting the request message to a content server to **instruct the content server to transmit content stored therein to the second client.**"

By contrast, *Kozdon et al.* discloses a system of providing call progress tones in a packetized network include storing the call progress tones and pre-programmed audio deliveries at a first device and includes multicasting or broadcasting the tones and deliveries from the first device to a number of telephony-enabled devices (Abstract and FIG. 2; see also col. 5: 29-63). Specifically, with respect to operation of the proxy server 40 (FIG. 2), *Kozdon et al.*, col. 5:32-53, states the following (*Emphasis Added*):

> An alternative embodiment is shown in FIG. 2. The network environment includes two proxies 40 and 42 that are positioned so as to be near the points at which the call progress tones or audio deliveries are to be transmitted. The call progress tones and deliveries are still multicast from the **server 10** in combination with the router 12, but the **proxies are used to receive and process the multicasts**. In the scenario in which the telephone 24 is engaged in an ongoing call with the remote telephone 34, but the caller at the telephone 24 wishes to enter into a short consultation call with the person at telephone 16, the proxy 40 may be used. **When the original telephone call goes on hold, the first call is transferred to the proxy 40**. The **telephone 24 uses CTI messages to control the playback of the call progress tones or audio deliveries to the party at telephone 34 from the proxy 40**. The proxy 40 uses the system-wide multicast announcement service from the server 10. The proxies may be low cost devices, since they do not need to have the capability to create or store announcements, music-on-hold and call status tones. The proxy units may be small units, because they rely upon the multicast service.

As clearly indicated in the above passages, the proxy server 40 merely receives and processes the multicasts, while the called telephone 24 controls the call. Consequently, it is not possible that server 40 performs any call control, much less in the manner claimed.

The Office Action (p. 4) correctly acknowledges (emphasis added), "Kozdon does not expressly disclose that the first server generates a request message or simply forwards a request message from another unit **or that the second server transmits the content directly to the second client.**" However, the Office action then states:

> Flockhart teaches a method (abstract) of providing content and applets to callers on hold (col. 1, line 1 – col. 2, line 65), where a first party (Fig. 1, #109) is called by a second party (Fig. 1, #99 and #100), and contacts an on-hold handling server (Fig. 1, #107) which then contacts a content server (Fig. 1, #103) separate from 107 (col. 3, lines 50-53), in which 107 sends information to 103 (col. 4, lines 25-27) and 103 determines the content to provide to the caller (col. 4, lines 27-50). At the time the invention was made, one of ordinary skill in the art would have added Flockhart's server separation method to Kozdon in order to ensure that the on-hold server's resources are not tied up (col. 1, lines 20-30).

Flockhart et al., at col. 3: 49-54, states:

> According to the invention, ACD 107 stores in its memory a plurality of applets 96-98 and an executable applet-selection function 103. Alternatively, applets 96-98 and function 103 may be implemented by a separate adjunct processor which cooperates with ACD 107. Applet 96 is a negotiation applet, described further below.

As best understood, the Office Action equates the "server" as recited by claim 1 with the ACD 107 of *Flockhart et al.* and the "another server" as recited by claim 1 with the "separate adjunct processor which cooperates with ACD 107" mentioned by *Flockhart et al.* However, *Flockhart et al.* (col. 4: 4-14) states:

> Function 103 causes ACD 107 to negotiate an in-queue or on-hold wait time with client 100, at steps 204 and 206. This illustratively involves EWT function 113 making an estimate (at one or more levels of service, where lower service equals longer wait time) of the expected wait time that the call will spend in queue or on hold waiting for an agent, and then downloading a negotiation applet 96 to client 100 that notifies client 100 of the estimated wait times and gives the client an option of agreeing to one of the wait times or not agreeing to the wait times and instead selecting being called back at a later time.

Function 103 then selects one or more of the applets 97-98 whose execution time satisfies the negotiated wait time (col. 4: 27-29). According to *Flockhart et al.* (col. 4: 46-49, emphasis added), "Once the applet 98 has be [*sic*] selected and customized, **function 103 causes ACD 107 to send that applet 98 to client 100 for execution**." Thus, any "content" transmitted thereby to client 100 of *Flockhart et al.* is transmitted to client 100 by the ACD 107, and not by the "separate adjunct processor which cooperates with ACD 107." Thus, there is no suggestion by

Flockhart et al. of "wherein the server is configured to generate a request message, in response to the hold condition, for performing call control on behalf of the first client by transmitting the request message to the other server to instruct the other server to transmit the content to the second client" as recited by claim 1, and the deficiency is not cured by any combination of *Kozdon et al.* and *Flockhart et al.* Therefore, Applicant respectfully requests that the obviousness rejection of independent claim 1 be withdrawn.

For reasons similar to those discussed previously, the obviousness rejection of independent claims 7, 13, 19, and 25 should also be withdrawn.

The rejection of dependent claims 3, 4, 6, 9, 10, 12, 15, 16, 18, 21, 22, 24, 27, 28, and 30 should be withdrawn for at least the same reasons as those discussed above with regard to their respective independent claims, and these claims are separately patentable on their own merits. For example, the Office Action (p. 4, item 11) states, "For claims 4, 10, 16, 22, 28, Kozdon teaches that the first client selects the content for transmission to the second client (col. 6, lines 3-5)." Applicants respectfully submit that *Flockhart et al.* teaches away from the combination of *Kozdon et al.* in view of *Flockhart et al.* suggesting this feature, as the function 103 (shown in the ACD 107, and **not** 109) of *Flockhart et al.* selects one or more of the applets 97-98 to be sent to the client 100. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the

principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP § 2143.01 As the Office Action's assertion regarding *Kozdon et al.* teaches away from its combination with *Flockhart et al.* at least with regard to claims 4, 10, 16, 22, 28, the rejection is unsustainable and should be withdrawn.

As regards the obviousness rejection of claims 2, 8, 14, 20, and 26, Applicant notes that the addition of *Anjum et al.* does not cure the deficiencies of *Kozdon et al.* and *Flockhart et al.* *Anjum et al.* is applied for a general teaching of the Session Initiation Protocol (Office Action, page 5, item 14).

With respect to the obviousness rejection of claims 5, 11, 17, 23, and 23, Applicant submits that the secondary reference of *Hazenfield* does not fill the gaps of *Kozdon et al.* and *Flockhart et al.* The Office Action (page 5, item 16) applies *Hazenfield* for a supposed disclosure of selecting and generating content for music-on-hold systems.

Accordingly, Applicant respectfully requests withdrawal of the obviousness rejections.

Therefore, the present application overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8501 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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